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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,563	12/05/2003	Tae-Ahn Jahng	559552000200	8911

25225 7590 04/05/2005  
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EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3732

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,563

Applicant(s)

JAHNG, TAE-AHN

Examiner

Pedro Philogene

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/02/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Justis et al. (6,530,929).

With respect to claim 5, Justis et al disclose a marking and guidance system for use during spinal surgery, comprising a means (280) for marking a location of an entry point on a vertebral bone for subsequent implantation of a securing member (61) of a spinal fixation device.

With respect to claims 6,7, Justis et al disclose all the limitations, as set forth in column 12, lines 44-67, column 13, lines 1-55.

With respect to claims 8-11, the method steps as set forth, would have been inherently carried out in the operation of the device, as set forth above.

With respect to claim 12, Justis et al disclose a system for marking and guiding the insertion of securing members of a spinal fixation device, comprising means, as set forth in column 12, lines 44-58, for inserting a marking pin at or near a desired entry point on a vertebral bone of a patient's spinal column; means for retracting retracting tissue outwardly and away from the marking pin so as to provide a surgical field of view

for insertion of securing member of a spinal fixation device; as set forth in column 12, lines 59-67, column 13, lines 1-19; means (100) for inserting the securing member (61) into the vertebral bone of the entry point by the marking pin (280).

With respect to claims 13,14, Justis et al disclose all the limitations, as set forth in column 12, lines 44-67, column 13, lines 1-55.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambin (4,573,448) in view of Mangiardi et al. (5,665,092).

With respect to claims 1-3, Kambin discloses a marking and guidance system for use during spinal fixation surgery comprising a guide tube (12) comprising a hollow cylindrical channel; a penetrating device (16) positioned within the hollow channel and having a sharp tip (FIG.2) a marking pin (18) to be inserted through the cylindrical channel of the guide pin, after removal of the penetrating device.

It is noted that Kambin did not teach of a pushing device to be inserted through the cylindrical channel of the guide tube and provide a driving force to the marking pin; as claimed by applicant. However, in a similar art, Mangiardi et al., evidence the use of a marking pin with a pusher device (2,4), so that the marking pin can be attached, detachably, and fixedly in rotation to the proximal end of the pushing device.

Therefore, given the teaching of Mangiardi et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kambin, as taught by Mangiardi et al., so that the marking pin can be attached, detachably, and fixedly in rotation to the proximal end of the pushing device.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kambin (4,573,448) in view of Mangiardi et al. (5,665,092) in view of Justis et al. (6,530,929).

With respect to claim 4, it is noted that the above combination of references did not teach of a securing device comprising a pedicle screw having a axial channel for receiving the second end of the and at least a portion of the marking pin therein; as claimed by applicant, However, in a similar art, Justis et al evidence the use of a pedicle screw with a longitudinal axial channel for receiving the end of the marking pin to maintain the pedicle screw in an aligned position.

Therefore, given the teaching of Justis, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a pedicle screw in the device of Kambin/Mangiardi, as taught by Justis et al to maintain the pedicle screw in an aligned position.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,468,279	10-2002	Reo
6,821,277	11-2004	Teitelbaum
6,596,008	07-2003	Kambin

6,575,979

06-2003

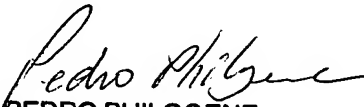
Cragg

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
March 31, 2005

  
PEDRO PHILOGENE  
PRIMARY EXAMINER